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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,044	07/30/2003	Chistopher Hsu	LEEE 200301	7391

27885 7590 12/19/2005

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EXAMINER	
RIVERA, WILLIAM ARAUZ	
ART UNIT	**PAPER NUMBER**
3654	

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/629,044	HSU ET AL.	
	Examiner	Art Unit	
	William A. Rivera	3654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 September 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-42* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-42* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☒ Interview Summary (PTO-413) Paper No(s)/Mail Date. *12/12/05*.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 8-9, 12-16, 21-22 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Noburo (Japanese Patent No. 04133973).

With respect to Claims 1, 8-9, 12-16, 21-22 and 38, Noburo, teaches a welding wire package comprising a drum 12 or box with a central axis, multiple layers of looped welding wire W defining a stack wire 11 to be paid out, said stack having an upper ring shaped surface with an outer cylindrical surface and an inner cylindrical surface defining a central bore concentric with said central axis and a flexible permanent magnet retainer ring 15 on top of said upper ring shaped surface, said retainer ring allowing welding wire to be paid from under the ring upwardly from said central bore.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Kenji (Japanese Patent No. 04112169).

With respect to Claim 1, Kenji, teaches a welding wire package comprising a drum 2 or box with a central axis, multiple layers of looped welding wire W defining a stack wire 4 to be paid out, said stack having an upper ring shaped surface with an outer cylindrical surface and an inner cylindrical surface defining a central bore concentric with said central axis and a flexible permanent magnet retainer ring 5 on top of said upper ring shaped surface, said retainer ring allowing welding wire to be paid from under the ring upwardly from said central bore.

Claims 27-28 and 31-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Farahmand (U.S. Patent No. 6,406,419).

With respect to Claims 27-28 and 31-32, Farahmand, Figures 8 and 9 and Column 4, lines 37-45, teaches a ring 20, said ring being a flat sheet of flexible permanent magnet material with an outer periphery and an inner periphery; said outer periphery having a diameter large enough to substantially cover the looped welding wire.

Claims 35-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Noburo (Japanese Patent No. 04133973) or Kenji (Japanese Patent No. 04112169).

With respect to Claim 35, Noburo or Kenji, teach a method of controlling the payout of a welding wire in a package at a welding operation, said package comprising a stack of multiple layers of looped welding wire 11,4, respectively, said method including applying a magnetic field to the top of said stack; and, pulling said wire from said stack for feeding to said welding operation.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2, 28, 39, and 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noburo as applied to claims 1, 8-9, 12-16, 21-22 and 38 above.

With respect to Claims 2, 28, 39, and 40-42, Noburo is advanced above. Noburo teaches all the elements of the welding wire package except for the thickness of the flexible ring.

However, it would have been an obvious to one of ordinary skill in the art, as determined through routine experimentation and optimization, to dimension the flexible ring of Noburo because one of ordinary skill would have been expected to have routinely experimented to determine the optimum dimensions for a particular use.

Claims 2-7, 10-11, and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenji as applied to claim 1 above.

With respect to Claim 2, Kenji is advanced above. Kenji teaches all the elements of the welding wire package except for the thickness of the flexible ring. However, it would have been an obvious to one of ordinary skill in the art, as determined through routine experimentation and optimization, to dimension the flexible ring of Kenji because one of ordinary skill would have been expected to have routinely experimented to determine the optimum dimensions for a particular use.

With respect to Claims 3-7, 10-11, and 17-20 Kenji is advanced above. Kenji teaches all the elements of the welding wire package except for the strength of the magnet. However, it would have been obvious to one of ordinary skill in the art as determined through routine experimentation and optimization, to dimension the flexible ring of Kenji to have the strength set forth in Claims 3 and 4, line 2 because one of ordinary skill would have been expected to have routinely experimented to determine the optimum dimensions for a particular use.

Claims 29 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farahmand as applied to claims 27-28 and 31-32 above.

With respect to Claims 29 and 33, Farahmand teaches all the elements of the welding wire package except for the strength of the magnet. However, it would have been obvious to one

of ordinary skill in the art as determined through routine experimentation and optimization, to dimension the flexible ring of Farahmand to have the strength set forth in Claim 29, line 2 because one of ordinary skill would have been expected to have routinely experimented to determine the optimum dimensions for a particular use.

Claims 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenji as applied to claims 1, 2, and 4 above, and further in view of Srail et al (U.S. Patent No. 5,942,961).

With respect to Claims 23-26, Kenji is advanced above. Srail et al, Columns 5, lines 46-60, teach the use of ferrite particles in a non-magnetic binder. It would have been obvious to one of ordinary skill in the art to provide Farahmand with a binder, as taught by Srail et al, for the purpose of maintaining the materials together.

Claims 30 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farahmand as applied to claims 27-28 and 31-32 above, and further in view of Srail et al (U.S. Patent No. 5,942,961).

With respect to Claims 30 and 34, Farahmand is advanced above. Srail et al, Columns 5, lines 46-60, teach the use of ferrite particles in a non-magnetic binder. It would have been obvious to one of ordinary skill in the art to provide Farahmand with a binder, as taught by Srail et al, for the purpose of maintaining the materials together.

Response to Arguments

Applicant's arguments filed September 19, 2005 have been fully considered but they are not persuasive.

With respect to applicants' remarks on pages 9-10 regarding the Noburo reference, it should be noted that this reference does teach flexibility due to the fact that the ring is made of a

synthetic resin and does teach an annular configuration. Further, the magnets are retained on the annular ring. Thus, the claims as set forth read on the Noburo reference.

With respect to applicants' remarks on page 10 regarding the Kenji reference, it should be noted that the term "flexible" is a relative term and all elements have some degree of flexibility. As such, the claim reads on the Kenji reference as set forth.

With respect to applicants' remarks on pages 10-11 regarding the Farahmand reference, it should be noted that the claims read on the Farahmand reference because there is no relationship between the size of the ring and the size of the wire set forth. For example, the looped welding wire may only at least two wires in a circle. If the wire is really thin, a user may place the ring of Farahmand on top of these wires, thereby meeting the limitation of the ring having a diameter large enough to cover the looped welding wire. Thus the claim is broad enough to cover this situation. As such, the claim reads on the Farahmand reference as set forth.

With respect to applicants' remark on pages 11-13 regarding the dependent claims, note the explanation above regarding Noburo and Kenji.

With respect to applicants' remarks on page 13-14 regarding claims 29 and 33, it should be noted that it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, applicants are merely claiming a ring.

With respect to applicants' remarks on page 14-15 regarding the combination with Srail, the examiner recognizes that references cannot be arbitrarily combined and that there must be

some reason why one skilled in the art would have been motivated to make the proposed combination of primary and secondary references. However, there is no requirement that a motivation to make the modification be expressly articulated in the primary reference. The test for combining references is what the combination of disclosures taken as a whole would have suggested to one of ordinary skill in the art. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures.

Conclusion

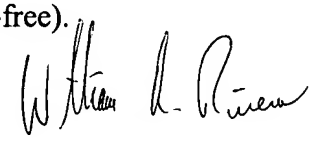
THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William A. Rivera whose telephone number is 571-272-6953. The examiner can normally be reached on Monday to Friday - 7:30 to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathy Matecki can be reached on 571-272-6951. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



WILLIAM A. RIVERA
PRIMARY EXAMINER

December 12, 2005